

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1-7 and 11-13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,059,719 to Yamamoto et al., (hereinafter "Yamamoto"). Additionally, the Examiner rejects claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,805,791 to Seuberth et al., (hereinafter "Seuberth"). Lastly, the Examiner rejects claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of U.S. Patent No. 6,916,284 to Moriyama (hereinafter "Moriyama").

In response, the Applicant respectfully traverses the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons set forth below. However, independent claims 1, 2 and 13 have been amended to clarify their distinguishing features.

Claim 1 recites a diathermic snare comprising a distal-end bending portion which is provided at the distal end of a loop section connected to the distal end of an operating wire, and which is bendable in a direction that intersects a plane formed by the loop section. Claims 2 and 13 have similar recitations.

By virtue of such a feature, it is possible to prevent the loop section from bumping against a projection in an inappropriate state. Consequently, the operation of looping the loop section around the cap section can be performed easily and reliably (see the specification, from page 20, line 13 to page 21, line 4).

Turning now to the prior art, Yamamoto does not disclose or suggest any structural element corresponding to the distal-end bending portion bendable in a direction which intersects the plane formed by the loop section. Furthermore, Figure 7 of Yamamoto

shows that a cylindrical cap section is provided at the distal end of an inserting section of an endoscope, and a flange-shaped projection, which is bendable inward, is provided at the distal end of the cap section. In the structure disclosed in Yamamoto, the entire loop section of the operating wire is engaged with a corner portion of an inner circumferential surface of the flange-shaped projection. In this case, an operation for locating the loop section of the snare at the flange-shaped projection (which will be hereinafter referred to as the looping operation) requires a great deal of skill. Thus, the looping operation cannot be easily achieved and the advantages gained by the diathermic snare of claim 1, the medical instrument system using a diathermic snare of claim 2 and the method of assembling a medical instrument using a diathermic snare of claim 13 cannot be obtained using the devices of Yamamoto.

Seuberth discloses a structure in which a wire loop 5 is attached to the distal end of a loop slider 4. However, Seuberth does not disclose or suggest any structural element corresponding to the distal-end portion bendable in the direction that intersects the plane formed by the loop section.

Moriyama discloses an endoscope hood having a projection 11 having a slanted surface and attached to a terminal of an endoscope (see Figure 2). Thus, Moriyama, like Yamamoto and Seuberth, does not disclose or suggest any structural element corresponding to the distal-end portion bendable in the direction that intersects the plane formed by the loop section.

With regard to the rejection of claims 1-7 and 11-13 under 35 U.S.C. § 102(b) as being anticipated by Yamamoto, a diathermic snare, a medical instrument system using a diathermic snare and a method of assembling a medical instrument using a diathermic snare having the features discussed above and as recited in independent claims 1, 2 and 3,

respectively, is nowhere disclosed in Yamamoto. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claims 1, 2 and 13 are not anticipated by Yamamoto. Accordingly, independent claims 1, 2 and 13 patentably distinguish over Yamamoto and are allowable. Claims 3-7, 11 and 12 being dependent upon claims 1 and 2 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-7 and 11-13 under 35 U.S.C. § 102(b) as being anticipated by Yamamoto.

With regard to the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Seuberth, a diathermic snare having the features discussed above and as recited in independent claim 1, is nowhere disclosed in Seuberth. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"² independent claim 1 is not anticipated by Seuberth. Accordingly, independent claim 1 patentably distinguishes over Seuberth and is allowable. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Seuberth.

With regard to the rejection of claims 8-10 under 35 U.S.C. § 103(a), since independent claim 2 patentably distinguishes over the prior art and are allowable, claims 8-10 are allowable therewith because they depend from an allowable base claim.

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

² Id.

In other words, independent claim 2 is not rendered obvious by the cited references because neither the Yamamoto patent nor the Moriyama patent, whether taken alone or in combination, teach or suggest a medical instrument system using a diathermic snare having the features discussed above. Accordingly, claim 2 patentably distinguishes over the prior art and is allowable. Claims 8-10 being dependent upon claim 2 are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 8-10 under 35 U.S.C. § 103(a).

Further with regard to the rejection of claims 8-10 under 35 U.S.C. § 103(a), the Moriyama reference has been assigned to Olympus Corporation, therefore, under 35 U.S.C. § 103(c) the subject matter of the Moriyama reference shall not preclude patentability under 103(a) when at the time the invention was made it was subject to an obligation of assignment to the same person. The present invention was assigned to Olympus Corporation, and was under such an obligation at the time of filing. Thus, since the Moriyama reference was assigned to Olympus Corporation at the time the present invention was made, the Moriyama reference cannot be used in a 35 U.S.C. § 103(a) rejection. Moriyama is prior art only under one or more of subsection 102(e), (f), and (g).

The instant application was filed on January 26, 2004. Under the *Guidelines to the Implementation of Changes to 35 USC 102(g) and 103(c) and the Interpretation of the Term "Original Application" in the American Inventors Protection Act of 1999*, Notice, 1233 OG 2 (April 11, 2000), the present application is entitled to the benefit of 103(c) (see, subsection II(A)(1)).

According to the *Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)*, 1241 OG 96 (Dec 26, 2000), the statement of an attorney or agent of record asserting common ownership at time the instant invention was made is sufficient evidence to disqualify the reference (see, section III, *Modified Policy on Evidence to Establish Common Ownership or an Obligation for Assignment to the Same Person*).

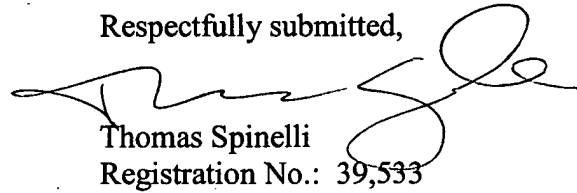
The Undersigned hereby states that both the instant application and U.S. Patent No. 6,916,284 to Moriyama were, at the time the invention of the instant application was made, owned by or subject to an obligation of assignment to Olympus Corporation. A copy of this statement is being submitted on a separate sheet attached hereto.

Accordingly, the Applicant respectfully submits that the Moriyama reference is improper and should not bar the patentability of claims 8-10 under 35 U.S.C. § 103(a). Consequently, the Applicant respectfully requests that the rejection of claims 8-10 be withdrawn. Additionally, new claims 16-18 have been added, in which claim 16 merges the features of original claims 1 and 8 and claims 17 and 18 recite the features of original claims 9 and 10, respectively.

Lastly, new claims 14 and 15 have also been added to further define the patentable invention. New claims 14 and 15 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 14 and 15. Applicants respectfully submit that new claims 14 and 15 are at least allowable as depending upon an allowable base claim (1).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

TS:jam/cm

Encl. (Statement Of Common Ownership To Disqualify
A Reference Under 35 USC § 103(C))



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tsutomu Okada
Serial No: 10/764,892
Filed: January 26, 2004
For: DIATHERMIC SNARE, MEDICAL INSTRUMENT SYSTEM USING THE SNARE, AND METHOD OF ASSEMBLING THE MEDICAL INSTRUMENT SYSTEM
Examiner: Beverly Meindl Flanagan
Art Unit: 3739
Docket: 17376
Dated: February 13, 2006

Conf. No.: 9699

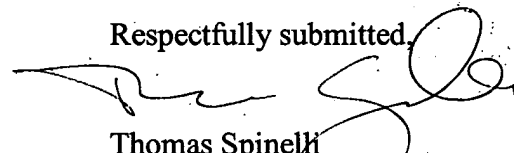
Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT OF COMMON OWNERSHIP TO DISQUALIFY
A REFERENCE UNDER 35 U.S.C. § 103(c)

Sir:

The Undersigned hereby states that both the instant application, U.S. Application Serial No. 10/764,892 and U.S. Patent No. 6,916,284 to Moriyama were, at the time the invention of the instant application was made, owned by or subject to an obligation of assignment to Olympus Corporation.

Respectfully submitted,


Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:jam/cm